

## **REMARKS**

Claims 84-95, 98-104, 108, and 112-123 were previously presented. Claims 83 and 120 are amended. New Claims 124-127 are added. Claim 119 is canceled. In view of these changes, claims 83-95, 98-104, 108, and 112-118, and 120-127 remain pending in the application.

### **Rejection of Claim 112 Under 35 USC §112**

Claim 112 is objected to for failing to further limit the subject matter of Independent Claim 83. The Office Action argues that the phrase "the sensor consists of the working electrode, counter electrode and reference electrode positioned on the substrate" is the same as the phrase "the sensor including a working electrode, a reference electrode and a counter electrode on a substrate." The difference in the cited phrases is the use of the term including versus the term consisting. These terms have different meanings in claims. For instance, MPEP §2111.03 provides that the term including is "inclusive or open-ended and does not exclude additional, unrecited elements" whereas "consisting of" excludes any element, step, or ingredient not specified in the claim." Accordingly, Dependent Claim 112 is a proper narrowing of Independent Claim 83.

### **Rejection of Claim 123 Under 35 USC §112**

Claim 123 is objected to for failing to further limit the subject matter of Independent Claim 83. The Office Action argues that "employing the measured current to determine the presence or quantity of a target analyte in the sample" is similar to "employing the potential to determine the presence or quantity of the target analyte in the sample." Claim 123 requires use of both current and potential where claim 83 requires only use of current. Accordingly, Claim 123 adds an element to Independent Claim 83 and properly narrows Claim 83.

### **Rejection of Claims 83-95, 98-101, 108, and 112-123 Under 35 USC §112**

Claims 123 is objected to for failing to further limit the subject matter of Independent Claim 83. This objection appears to be based on the belief that the claim is internally inconsistent. For instance, the Office Action argues that "the potential difference is between the counter electrode and the working electrode since 'the current through the working electrode is

balanced by a current through the counter electrode'. Thus, it is unclear as to 'controlling a potential difference between the reference electrode and the working electrode.'"

In a three electrode system, there can be more than one potential difference between electrodes. For instance, a potential between the counter electrode and the working electrode can be different from a potential between the reference electrode and the working electrode. The potential between the counter electrode and the working electrode can be an externally applied potential that is a source for the current through the counter electrode. Changing the potential difference between the counter electrode and the working electrode can affect the potential difference between the working electrode and the reference electrode. As a result, a potential applied between the working electrode and the counter electrode can be used to control the potential difference between the working electrode and the reference electrode. In fact, Paragraph [0008] provides that an "objective is to control the potential difference between a ... (working electrode) 60 and a reference electrode 70 by the application of a current via the ... (counter electrode) 80." Accordingly, the potential applied between the working electrode and the counter electrode can be used to control the potential difference between the working electrode and the reference electrode. Controlling the potential difference between the reference electrode and the working electrode changes the potential of the working electrode and can accordingly be controlled so as to cause the redox reaction. As a result, "controlling (the) potential difference between the reference electrode and the working electrode ... (causes the) redox reaction between a component in the sample and the working electrode" as is specified in Independent Claim 83. Hence, Independent Claim 83 is internally consistent and definite.

#### **Rejection of Claims 83 Under 35 U.S.C. §102 in View of Choong, et al.**

Claim 83 has been amended to include subject matter from Dependent Claim 119. Claim 119 stands rejected as being anticipated by U.S. Patent Number 6,518,024 (Choong).

"To anticipate a claim, the reference must teach every element of the claim." See MPEP §2131. The amended version of Dependent Claim 83 and prior Independent Claim 119 each specify a sensor including a working electrode, a reference electrode and a counter electrode on a substrate with "a self-assembly monolayer being positioned on at least one of the electrodes." Choong does not teach a self-assembly monolayer positioned on at least one electrode of a sensor including a working electrode, a reference electrode and a counter electrode on a

substrate. Accordingly Choong does not teach every element of Dependent Claim 83 and does not anticipate Independent Claim 83.

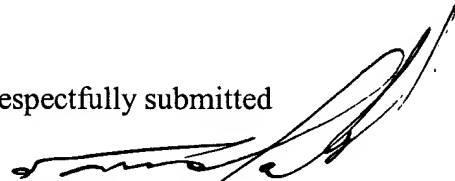
**Rejection of Claims 83-95, 98-104, 108, and 112-118, and 120-123**

Claims 83-95, 98-104, 108, and 112-118, and 120-123 are dependent from Independent Claims 83. Because the Independent Claim 83 is believed to be in condition for allowance, these claims are also believed to be in condition for allowance.

## CONCLUSION

The amendments set forth above are presented for a discussion scheduled for November 30, 2004. The Examiner is encouraged to telephone the undersigned with any questions.

Respectfully submitted



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